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| 10/781,114 | 02/18/2004 | George Hoehne | P04.0001 | 1951 |
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| SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473 | | | EXAMINER CHEUNG, VICTOR | |
| | | | ART UNIT 3709 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/781,114

Applicant(s)

HOEHNE ET AL.

Examiner

Victor Cheung

Art Unit

3709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/29/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/18/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/18/2004</u> <u>6/4/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The response to examiner's restriction requirement, filed December 29, 2006, has been entered. Applicant has elected Group I (claims 1-10 and 21) with traverse, which are examined on the merits below. Groups II and III (claims 11-20) have not been elected, and thus have been withdrawn from consideration.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig. 4A, Reference Number 29, Fig. 4B, Reference Number 36. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The use of the trademark Java Virtual Machine (JVM)TM has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 9 and 10 both include the limitation of “wherein all method elements except using the electronic cash for purchase” in lines 1-2. The limitation as claimed is not described in the specification. On page 10, paragraph 26 of the specification, the steps of transferring the value from the retailer to the subscriber, where the retailer provides the value to a retail charging terminal that then transfers the value into the mobile appliance is done in a contemporaneous manner or in a geographically proximate manner. The specification excludes the “giving” and the “using” steps of claim 1, lines 2 and 9, respectively, not only the “giving” step as claimed. Also refer to the 35 U.S.C. 112, second paragraph rejections below regarding the phraseology used claims 9 and 10.

5. The disclosure is objected to because of the following informalities:

- Page 17, Paragraph 41, Line 2: “154” should be –152--.

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- Page 17, Paragraph 41, Line 4: "152" should be --154--.

Appropriate correction is required.

Claim Objections

6. Claims 1, 6, 12, and 18 are objected to because of the following informalities:
 - Re Claim 1, Line 4: "the money" should be --the amount of money--.
 - Re Claim 2, Line 2: "the transfer of money" should be --the transferring electronically the amount of money--.
 - Re Claim 6, Line 1: "the transferring of the money" should be --the transferring electronically the amount of money--.
 - Re Claim 21, Line 13: "the short-range communications" should be --the first short-range communications network--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3, 4, 7, 9, 10, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Re Claim 3: Claim 3 recites the limitation "initiating of the retail charging terminal" in Line 3. There is insufficient antecedent basis for this limitation in the claim. It is suggested that "initiating of the retail charging terminal" be changed to --initiating of the transferring of money from the retail charging terminal to the mobile appliance--.

Re Claim 4: Claim 4 recites the limitation "the electronic money" in line 3. There is insufficient antecedent basis for this limitation in the claim. For this office action it is understood that "the electronic money" read as --the amount of money--.

Re Claim 7: Claim 7 contains the trademarks/trade names Bluetooth®, WiFi®/802.11 (note: 802.11 is WiFi), and USB®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademarks/trade names are used to identify/describe various short-range wired and wireless connections and, accordingly, the identification/description is indefinite.

Re Claims 9 and 10: Claims 9 and 10 recite the limitation "wherein all method elements except" each in line 1. It is unclear as to what the limitation "wherein all method

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elements except" refers to. If applicant is referring to the method steps of claim 1, they should be specifically cited.

Claims 9 and 10 recite the limitation "using the electronic cash for purchase" in Line 2. There is insufficient antecedent basis for this limitation in the claim. There is no "electronic cash" in claim 1.

Re Claim 21: Claim 21 recites the limitation "a short-range communications network" in line 5 and also in line 10. If the first and second instances of "a short-range communications network" are to be treated as distinct, different terminology should be used.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-7, and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (US Patent No. 5,796,832) in view of Piikivi (US Patent Application Publication No. 2002/0198849) and Crevelt et al. (US Patent No. 5,902,983).

Re Claim 1: Kawan teaches a wireless transaction method for purchasing goods and services (Col. 5, Lines 43-45) including receiving, by a retail charging terminal, an amount of money in either hard currency or electronic form (Col. 4, Lines 54-56), transferring

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electronically the amount of money from the retail charging terminal to a smart card of a subscriber by a smart card reader (Col. 4, Lines 56-67), and using the smart card by the subscriber to make purchases (Col. 5, Lines 46-49). The money involved is generally provided by a financial institution or a financial network (Col. 2, Lines 14-16).

However, Kawan does not specifically teach purchasing an opportunity in a game of chance, giving the amount of money to a retailer/financial institution who is an authorized agent for the game of chance, or the use of a mobile appliance.

Piikivi teaches of known payment procedures called mobile banks used by companies with accounts for each customer, where the account's funds are transferred by the user from his other source (a separate bank account), and use of the mobile bank system is limited to service or goods providers who have made an agreement with the mobile bank (Page 1, Paragraph 4). Piikivi also teaches that money can be stored in the SIM (Subscriber Identity Module – a smart card) of the mobile device of the user (Fig. 1, Reference No. 13; Page 3, Paragraphs 40 and 45).

Crevelt et al. teach that it is well known in the art for cashless credit systems to be implemented for wagering in casino establishments (Col. 2, Lines 4-17).

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the transaction method for purchasing an opportunity in game of chance. As taught in Crevelt, by providing a cashless crediting wagering method, a player of the game of chance is allowed to remain at a gaming machine for extended periods of time, providing the gaming establishment with increased revenue. The ability for customers to spend funds without the need to have physical cash on hand would increase the revenue of any commercial business.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a financial account with a gaming establishment offering a game of chance, and give an amount of money into the financial account for purchasing the game of chance. Gaming establishments often have house accounts where funds are necessarily managed directly between the customer and the establishment. Establishing the house account allows access to the establishment's products and services.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a mobile appliance comprising a smart card to receive the amount of money and then use the mobile appliance to purchase the game of chance. It is well known that mobile appliances are versatile appliances that include telephonic capabilities, web browsing, messaging services, are commonly carried by individuals for their various utilities, and already carry a smart card/SIM card for a number of functions.

Re Claim 2: Kawan, as modified by Pukivi and Crevelt et al., teaches the limitations of claim 1 as discussed above.

However, Kawan does not specifically teach initiating of the transferring electronically the amount of money from the retail charging terminal to the mobile appliance by the retail charging terminal.

Kawan teaches that the terminal may review account balances, transfer funds, reload monetary values, or perform other activities typically available on a fixed-location ATM (Col. 6, Lines 40-48).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to initiate the transferring electronically the amount of money from the

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retail charging terminal to the mobile appliance by the retail charging terminal. As taught in Kawan, the terminal is able to perform other activities typically available on fixed-location ATMs. Because the charging terminal is equipped with a keypad and card reader, it is the charging terminal that performs the operations of manipulating the amount of money on the smart card. Since the terminal is the only device with which a user would control the operations between the terminal and the smart card, it would have been obvious to have the charging terminal initiate the transferring electronically the amount of money from the retail charging terminal to the mobile appliance.

Re Claim 3: Kawan, as modified by Piikivi and Crevelt et al., teaches the limitations of claim 2 as discussed above.

However, they do not specifically teach waking the mobile appliance from a sleep state to a waking state by the initiating of the transferring electronically the amount of money from the retail charging terminal to the mobile appliance by the retail charging terminal.

It is well known in the art that mobile appliances are in a sleep state until an action requiring the mobile appliance is performed, such as an incoming call, an incoming message, and user manipulation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to wake the mobile appliance from a sleep state to a waking state by the initiating of the transferring electronically the amount of money from the retail charging terminal to the mobile appliance by the retail charging terminal. Having the mobile appliance in a sleep state conserves battery power, which is essential to the usefulness of the mobile

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appliance. Because the retail charging terminal is used to initiate the transfer, the mobile appliance would wake from a sleep state to a waking state.

Re Claim 4: Kawan, as modified by Piikivi and Crevelt et al., teaches the limitations of claim 1 as discussed above.

However, Kawan does not specifically teach providing a subscriber identity module on the mobile appliance, and transferring the amount of money onto the subscriber identity module.

Piikivi teaches that money can be stored in the SIM (Subscriber Identity Module – a smart card) of the mobile device of the user (Fig. 1, Reference No. 13; Page 3, Paragraphs 40 and 45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a SIM card in the mobile appliance and store the amount of money in the SIM card. As discussed in Kawan, claim 1, above, the amount of money is transferred from the retail charging terminal to a smart card. A benefit of using smart cards is that, as an electronic memory, they have the ability to include security and authorization protocols (Kawan, Col. 2, Lines 12-19). Mobile appliances are well known to include smart cards, commonly known as subscriber identity modules in mobile telephonic appliances.

Re Claim 5: Kawan, as modified by Piikivi and Crevelt et al., teaches the limitations of claim 1 as discussed above.

However, Kawan does not specifically teach downloading memory structures into the subscriber identity module if they do not already exist.

Piikivi teaches that an electronic wallet is installed, or can be installed, into the electronic device's memory or SIM card (Page 5, Paragraph 59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to download the memory structures into the subscriber identity module if they do not already exist. For the transactions to be successfully implemented, the mobile device must be prepared to communicate and accept the money.

Re Claim 6: Kawan, as modified by Piikivi and Crevelt et al., teaches the limitations of claim 1 as discussed above.

Kawan additionally teaches that information on the smart card can be exchanged with a smart card reader through a serial interface, a short-range communications mechanism and protocol (Col. 4, Lines 17-23).

Re Claim 7: Kawan, as modified by Piikivi and Crevelt et al., teaches the limitations of claim 6 as discussed above.

However, Kawan does not specifically teach that the step of transferring the money comprises short-range communications selected from the group consisting of Bluetooth®, WiFi®, infrared, and USB® (please refer to 35 U.S.C. 112 rejection regarding trademark use).

Piikivi teaches that the mobile appliance is equipped with Bluetooth® or infrared communication technologies to communicate between the mobile appliance and the vending machine (Page 3, Paragraph 46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to additionally use the short-range communications to transfer the amount of money. Using wireless protocols allows the user to perform the required actions without physically coming in contact with the retail charging terminal. Bluetooth®, WiFi®, infrared, and USB® are all well known technologies for wired or wireless communications.

Re Claim 9: Kawan, as modified by Piikivi and Crevelt et al., teaches the limitations of claim 1 as discussed above.

However, they do not specifically teach that all the method elements except using the mobile appliance by the subscriber to purchase the opportunity in the game of chance in a contemporaneous manner.

Kawan teaches that the transaction system is used similarly to a credit authorization terminal (Col. 4 Line 57 – Col. 5 Line 9).

Piikivi teaches that the purchasing method can be used when a customer wished to make a purchase (Page 2, Paragraph 32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method steps of claim 1 in a contemporaneous manner, such as when a customer wishes to make a purchase. The purpose of the inventions is to make such transactions easier and more convenient, and thus, not require long stretches of time.

Re Claim 10: Kawan, as modified by Piikivi and Crevelt et al., teaches the limitations of claim 1 as discussed above.

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However, they do not specifically teach that all the method elements except using the mobile appliance by the subscriber to purchase the opportunity in the game of chance in a geographically proximate manner.

Kawan teaches that the transaction system can be used in connecting a private network or in a geographic area (Col. 3, Lines 27-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method steps of claim 1 in a geographically proximate manner. The financial transaction system can be suited to the provider's needs, and for a private network, a geographically proximate area may be required.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (US Patent No. 5,796,832) in view of Piikivi (US Patent Application Publication No. 2002/0198849) and Crevelt et al. (US Patent No. 5,902,983) as applied to claim 1 above, and further in view of Sharp et al. (US Patent Application Publication No. 2002/0002510).

Kawan, as modified by Piikivi and Crevelt et al., teaches the limitations of claim 1 as discussed above. Piikivi also teaches that applications can be installed into the electronic device's memory or SIM card (Page 5, Paragraph 59).

However, they do not specifically teach downloading games from a game server over a long-range communications network.

Sharp et al. teaches a system and method comprising a mobile phone content provider, including games, and a mobile phone capable of downloading the games from the content provider from a server (Page 1, Paragraphs 7 and 10).

It is well known in the art that mobile appliances have the capability to download games and applications. It would have been obvious to one of ordinary skill in the art at the time the invention was made to download the games from a game server over a long-range communications network. By providing games and content, the mobile appliance manufacturer benefits from increased traffic and subscriptions, and the user benefits from the innovative content.

12. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (US Patent No. 5,796,832) in view of Piikivi (US Patent Application Publication No. 2002/0198849).

Kawan teaches a retail charging terminal configured to be loaded with cash value by a retailer who is an authorized agent of a service (Col. 1, Lines 5-9; Col. 2, Lines 29-32), the retail charging terminal comprising a second short-range communications network configured to communicate with the short-range communications network of a smart card and transfer the e-cash to the smart card over the short-range communications network (Col. 6, Lines 36-54).

However, Kawan does not specifically teach a mobile appliance comprising a mechanism for making retail purchases over a long-range wireless communications network, and for obtaining e-cash over a short-range communications network, the mobile appliance comprising a subscriber information module configured to hold and transfer the e-cash.

Piikivi teaches a mobile appliance comprising a smart card, a long-range wireless communications network for financial transactions (Page 3, Paragraphs 43, 45), a short-range communications network for transactions (Page 3, Paragraph 46), the mobile appliance

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comprising a subscriber information module configured to hold and transfer the e-cash

(Page 3, Paragraphs 40 and 45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a mobile appliance comprising a smart card to store e-cash and make financial and purchasing transactions. It is well known in the art that mobile appliances are versatile appliances that include short-range and long-range communications capabilities, telephonic services, web browsing, messaging services, and are commonly carried by individuals for their various utilities. It is well known in the art that mobile appliances have the capability of making retail purchases over a long-range wireless communications network. It would have been obvious to utilize the smart card contained in a mobile appliance instead of a stand-alone smart card because of the mobile appliance's portability and wide use.

Response to Arguments

Applicant's election with traverse of claims 1-10 and 21 in the reply filed on 12/29/2006 is acknowledged. The traversal is on the ground(s) that a search of the non-elected groups would not be unduly burdensome given the interrelationship between the claimed and unclaimed subject matter in the respective groups, and that art found in one class/subclass is likely to be related to art found in the other class/subclass(es).

This is not found persuasive under the original reasoning of combination/subcombination. Although Groups I, II, and III are used in a combination, the limitations and particulars of the claims in Groups II and III would create a serious burden

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required by the additional searching under the groups' respective class/subclasses. The requirement is still deemed proper and is therefore made FINAL.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Jonstromer discloses a communication device including a smart card for storing electronic credits and conducting financial transactions over a telecommunications network.
- Nguyen et al. disclose a method for cashless gaming including a wireless communication device, and transferring credit from a financial center to the wireless communication device or a casino.
- Hultgren discloses a telecommunications payment method where a customer transfers money from a financial account into a merchant account, whereby the money can then be used for transactions with the merchant.
- Vlazny et al. disclose a system for manipulating and using funds for pari-mutuel wagering, including a financial account set up with a gaming administrator, making funds available at a gaming terminal for a player, with or without the use of a credit instrument.

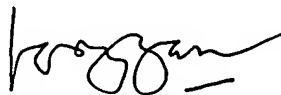
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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Cheung whose telephone number is (571) 270-1349. The examiner can normally be reached on Mon-Thurs, 8-4:30, and every other Fri, 8-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee can be reached on (571) 272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VC
02/02/2007


KIM NGUYEN
PRIMARY EXAMINER